Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUTAKA NAKATSU, SHIN IIMA, KAYOKO OHYOSHI,
and TOMOMI NAKAMURA

Appeal No. 1999-2345
Application No. 08/610,758

ON BRIEF[1]

Before RUGGIERO, LALL, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, which are all the claims in the application.

We affirm.

[1] Appellants waived oral hearing; see fax communication filed July 2, 2001.

BACKGROUND

The invention is directed to a video printer having an operation system on the housing which can control functions of an attached video camera. Representative claim 1 is reproduced below.

> 1. A video printer for printing on a printing paper as a hard copy a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images, said printer comprising:
>
> a video printer housing portion with a video camera attached thereto;
>
> a signal input and output connection terminal disposed on said video printer housing portion for electrically connecting said video camera attached to said video printer housing portion to said video printer; and
>
> an operation system disposed on said video printer housing portion for operating said video camera.

The examiner relies on the following references:

Itoh et al. (Itoh)	4,935,763	Jun. 19, 1990
Finelli et al. (Finelli)	4,937,676	Jun. 26, 1990
Nagano	5,561,462	Oct. 1, 1996 (effectively filed May 24, 1990)
Beveridge et al. (Beveridge)	5,621,492	Apr. 15, 1997 (filed Jan. 25, 1995)

Claims 1, 3, and 5-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Finelli and Beveridge.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Finelli, Beveridge, and Itoh.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Finelli, Beveridge, and Nagano.

We refer to the Final Rejection (mailed Nov. 9, 1998) and the Examiner's Answer (mailed Apr. 16, 1999) for a statement of the examiner's position and to the Brief (filed Mar. 19, 1999) and the Reply Brief (filed Jun. 14, 1999) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants submitted an amendment on May 22, 1998, subsequent to the examiner's Final Rejection, which was entered by the examiner. We note, however, that appellants' Reply Brief contains a section referring to a "proposed amendment." The examiner did not indicate consideration of the "proposed amendment" as submission of an amendment after final action, as contemplated by 37 C.F.R. § 1.116. The Reply Brief section was not marked as a proposed amendment under 37 C.F.R. § 1.116. Nor do the accompanying remarks indicate that the "proposed amendment" was to be considered for entry prior to jurisdiction of the application passing to the Board: "Alternatively, should the Board determine that the Examiner has properly construed the teachings of Beveridge, Appellant [sic] proposes the following amendment to the claims...." (Reply Brief at 4.) We therefore consider the claims before us as amended by appellants' submission filed May 22, 1998, and consistent with the Appendix of claims submitted with appellants' principal brief (filed Mar. 19, 1999).

The rejection of claims 1, 3, and 5-7 under section 103 as being unpatentable over Finelli and Beveridge is set forth on pages 4 through 6 of the Answer. The examiner turns to Beveridge to remedy a perceived deficiency of the Finelli reference. According to the examiner, Finelli "does not explicitly show the use of a video camera which is capable of capturing continuous motion images, so that one video picture from a plurality of continuous video pictures can be selected." (Answer at 5.)

Appellants, for their part, contend (e.g., Brief at 6-7) that language in the preamble of claim 1 distinguishes over the applied prior art. Claim 1, however, purports a "video printer," rather than a video camera suitable for recording continuous motion images. The claim, by its terms, appears to set forth a video printer for use with a video camera suitable for recording continuous motion images. The preamble language thus might be viewed as failing to further define or limit the invention. The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Perhaps appellants wish to claim the combination of a video printer and a video camera. Appellants describe, as at pages 4 through 6 of the instant specification, and in instant Figure 2, a video printer 1 and a separate, attachable video camera 6.

In any event, appellants argue that Beveridge teaches "still image photography," and the combination of Finelli and Beveridge thus cannot teach "a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images," as recited in claim 1. The examiner responds (Answer at 9) that

Beveridge uses a "frame grabber" for selecting still images, but the still images are selected from a plurality of video pictures recorded by a video camera as continuous motion images. Appellants, in turn, respond that "[i]n the claimed invention, the image is selected from recorded images for the purpose of printing, not for viewing, reconstructing the image, photographing and then printing as in Beveridge." (Reply Brief at 4.)

Appellants do not point out where the alleged distinguishing feature may be found in the claims. Instant claim 1 does not exclude additional operations of viewing, reconstructing, and photographing prior to printing. Moreover, appellants' arguments are not responsive to the combined teachings of the references. Beveridge is relied upon for the suggestion of using a video camera, recording a plurality of video pictures as continuous motion images, for the purpose of facilitating selection of images that are to be printed on a hard-copy medium. We agree with the examiner's finding that Beveridge suggests the limitation; see especially column 2, lines 17 through 30 of the reference.

We also fail to see how the language of claim 1 might exclude use of a strobe, contrary to implications in the arguments presented on pages 11 and 12 of the Brief. Nor do appellants point out language in the claim that is thought to exclude using a strobe -- even assuming that the combined teachings of Finelli and Beveridge require the use of a strobe.

Because we find appellants' arguments to be not commensurate with the scope of claim 1, and appellants have not shown the examiner's findings with respect to the teachings of the references to be in error, we sustain the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Finelli and Beveridge. Arguments not relied upon are deemed waived. See 37 C.F.R. § 1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.") Claims 3 and 5-7 fall with claim 1, as appellants have chosen not to rely on the limitations of the dependent claims. See 37 C.F.R. § 1.192(c)(7).

We also sustain the rejection of claim 4 under section 103 as being unpatentable over Finelli, Beveridge, and Itoh, and the rejection of claim 2 as being unpatentable over Finelli, Beveridge, and Nagano. Appellants have not alleged error in the examiner's finding that Itoh would have suggested the further limitations of claim 4, drawn to well-known video camera operations. Nor have appellants alleged error in the examiner's finding that Nagano would have suggested the LCD display monitor as recited in instant claim 2.

We note that appellants' specification, at pages 1 through 2, and in instant Figure 1, describes a prior art video printer system having a video printer 31 connected to a video camera 32 and a video monitor 34. We further note that Finelli suggests, especially at column 6, line 65 through column 7, line 3, controlling functions of an associated electronic camera by means of switches in a printer control panel.

We agree with the examiner's ultimate conclusion that the subject matter on appeal is unpatentable under 35 U.S.C. § 103 in view of the references applied. However, should appellants elect further prosecution of the instant subject matter, the examiner should consider entry of a 35 U.S.C. § 103 rejection based on appellants' admitted prior art in view of the teachings of Finelli against any claim of scope similar to that of present claim 1.

CONCLUSION

The rejection of claims 1-7 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JOSEPH F. RUGGIERO Administrative Patent Judge	)
PARSHOTAM S. LALL Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

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